

Remarks

Claims 1-23 are in the case. Of the claims, claim 15 has been amended for grammatical improvement. Claims 1-10, 14-17, and 20-23 stand rejected over Schittenhelm (3746362) in view of Dussia et al (5795028) and Herrmann (4087942). Claims 11-13 and 18-19 stand rejected under the previous combination in further view of Humphrey (4148164).

I. Claims Rejections under 35 U.S.C. 103

A claimed invention is unpatentable under 35 U.S.C. §103 if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. 35 U.S.C. § 103 (1994); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966). The ultimate determination of whether an invention is or is not obvious is a legal conclusion based on underlying factual inquiries, including (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18.

A. The Examiner has the Burden to Establish a Prima Facie Case of Obviousness

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. MPEP §2142. If the Examiner does not establish a *prima facie* case, the applicant is under no obligation to respond. MPEP §2142. To reach a proper determination under §103, the Examiner must step backward in time and into the shoes of the hypothetical person of ordinary skill in the art when the invention was unknown and just before it was made. MPEP §2142. The tendency to resort to “hindsight” based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and

the legal conclusion must be reached on the basis of the facts gleaned from the prior art. MPEP §2142.

B. Prior Art References Must Be Analogous

To rely on a reference it must be analogous art – meaning – “the reference must either be in the field of the Applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). References are within the same field of endeavor when they “have essentially the same function and structure.” *In re Deminski*, 796 F.2d 436, 422, 230 U.S.P.Q. 313, 315 (Fed. Cir. 1986). See also *In re Ellis*, 476 F.2d 1370, 1372, 177 U.S.P.Q. 526, 527 (CCPA 1973). “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659, 23 U.S.P.Q.2d 1050, 1061 (Fed. Cir. 1992). In other words, it is necessary for the PTO “to consider ‘the reality of the circumstances’ – in other words, common sense – deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” *In re Oetiker*, 977 F.2d at 1447, 24 U.S.P.Q.2d at 1446.

C. Criteria/Analysis the Examiner Must Meet to Establish a *Prima Facie* Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met by the Examiner.

1. Motivation to Combine

First, there must be some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify

the reference or to combine reference teachings. “There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998).

The showing of a motivation to combine or modify prior art must be clear and particular, and broad conclusory statements about the teachings of one or more references, standing alone, are not “evidence.” *In re Dembicza*k, 175 F.3d 994, 1000, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Further, the showing of obviousness “requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references.” *Dembicza*k, 175 F.3d at 999, 50 U.S.P.Q.2d at 1617.

Ultimately, this first criterion provides “the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis.” *Dembicza*k, 175 F.3d at 999, 50 U.S.P.Q.2d at 1617. This is because “most if not all inventions arise from a combination of old elements,” potentially allowing every element of the claimed invention to be found in the prior art. *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000). Solely identifying each element of the claimed invention in the prior art is not enough to defeat patentability of the invention as a whole, unless there existed a teaching, suggestion, or motivation to combine the prior art references. *Kotzab*, 217 F.3d at 1370, 55 U.S.P.Q.2d at 1316-17. Otherwise, “rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing

together elements in the prior art to defeat the patentability of the claimed invention.” *Rouffet*, 149 F.3d at 1357, 47 U.S.P.Q.2d at 1457. Thus, the initial burden is on the examiner to establish the existence of a teaching, suggestion, or motivation to combine the prior art references at the time the invention was made.

2. Reasonable Expectation of Success

Second, there must be a reasonable expectation of success. Whether an art is predictable or whether the proposed modification or combination of the prior art has a reasonable expectation of success is determined at the time the invention was made. *Ex parte Erlich*, 3 U.S.P.Q.2d 1011 (Bd. Pat. App. & Inter. 1986). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

3. Prior Art Must Teach or Suggest All the Claim Limitations.

The third and final requirement for a finding of obviousness requires the prior art reference (or references when combined) to teach or suggest all the claim limitations. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (COCA 1970).

I. Argument

A. Dussia and Hermann are Nonanalogous to the Trailer Frame Art and To Each Other.

Neither Dussia nor Hermann are in the field of the Applicant’s endeavor or reasonably pertinent to the particular problem with which the inventor was concerned. The present application as required by the claims is directed to brackets for trailer frames and trailer frames.

Dussia, on the other hand, is directed to a La-Z-Boy® occasional chair, and Hermann is directed to a steel door.

Clearly, occasional chairs and steel doors are not in the same field of endeavor as brackets for trailer frames. Likewise, recliners and steel doors are not “reasonably pertinent to the particular problem with which the inventor was concerned.” Such an analysis involves “deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” In this case, one of ordinary skill in the art would simply not look to the “recliner” and “steel door” art in solving the problems associated with manufacturing a bolt-together trailer frame that strong and durable.

The applicant further notes that it is improper to allege that the references are analogous simply because the bracket of Dussia bolts onto another “frame.” Such an analysis virtually eliminates the requirement altogether that prior art patents be analogous, and provides an unlimited license to use hindsight reconstruction to piece together the different parts of an applicant’s invention from various obscure fields that the applicant is not charged with the knowledge of. Rather, the point of the requirement that the references must be analogous is to insure that a rejection is based on a combination of references, all of which the applicant should have been aware. In this case, the applicant respectfully asserts that it is unreasonable to think that one of ordinary skill in the art would think to combine an occasional chair and steel door with a trailer frame when developing components of the present invention.

Therefore, the applicant respectfully asserts that the combinations are improper and that all pending claims should be allowable for at least this reason.

B. There is No Motivation to Combine the Combination of References

The Examiner has the burden of establishing Motivation to Combine by setting forth clear and particular evidence. In this case, the Examiner has not introduced evidence of some teaching, suggestion, or motivation that would cause one of ordinary skill to combine a welded trailer frame patent with an occasional chair patent and a steel door patent. The applicant respectfully asserts that no such motivation existed.

C. There is No Likelihood of Success in the Combination of References

Similarly, the Examiner has the burden of establishing from the prior art that the resulting combination was likely to be successful. The applicant respectfully asserts that the Examiner has not met her burden, and that there was no likelihood of success in combining such unrelated devices.

D. The Prior Art Does Not Teach all of the Claim Limitations.

1. Rejection of claims 15-21 and 23.

Each of claims 15-21 and 23 require a trailer frame with longitudinal members, cross-members, and A-frame members. The Schittenhelm trailer frame does not have all three frame members. Rather, Schittenhelm only has A-frame members and cross-members. As such, claims 15-21 and 23 should be allowable for at least this reason, as the combination does not teach all the claim elements.

Additionally, claims 15-21 and 23 require a bolted connection between frame member. The Examiner notes that the attachment of the various frame members are “assumably” attached by bolts. Such an assumption, even absent evidence to the contrary, would not satisfy the Examiner’s burden of proving obviousness. However, in this case Schittenhelm expressly states only one mechanism for attaching the frame members—by welding. Column 3, lines 11-17 of Schittenhelm states:

“A rear traverse beam 14 which has a “Z”-shaped cross-section is attached, preferably by welding, onto the end of beams 11 and 12 as can be seen more clearly in FIG. 2. A median traverse beam 15 which is also “Z”-shaped is welded to the side beams 11 and 12 in the middle section of the “A”-frame by means of corner element 24 (FIG. 3).”

Furthermore, assuming *arguendo* that the device of Herrmann includes a bracket with “dimples,” as understood, such “dimples” are not in engagement with any recesses. Claim 22 is allowable for at least this reason.

Pursuant to the foregoing, the applicant respectfully requests a Notice of Allowance be issued in due course.

Respectfully submitted,

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